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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,865	06/07/2001	Mark Andrew Benny	AUS9-2001-0208-US1	9366

7590 11/20/2006
Kelly K. Kordzik
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EXAMINER

FREJD, RUSSELL WARREN

ART UNIT PAPER NUMBER

2128

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,865

Applicant(s)

BENNY ET AL.

Examiner

Russell Frejd

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Examination of Application #09/875,865

1. Claims 25-30 of application 09/875,865, filed on 7-June-2001, are pending in the application. This communication is in response to the amendment received on 24-August-2006.

Claim Rejections under 35 U.S.C. § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

- 2.1 Claims 25-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- 2.2 MPEP Section 2106(IV)(B)(2)(b)(ii) provides that a statutory computer process is determined not by how the computer performs the process, but by what the computer does to achieve a practical application with a useful, concrete and tangible result. For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory, while a claimed process for digitally filtering noise employing the mathematical algorithm is statutory. The long line of cases in this area that are referred to in MPEP Section 2106(IV)(B)(2)(b)(ii) exemplify this requirement, by utilizing in the claim language, terms such as controlling, executing, changing and removing. In view of the aforementioned requirement and the interim guidelines for 101 subject matter eligibility, which are now included in section 2106 of the MPEP 8th Edition, the Examiner respectfully contends that the claim language of

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independent claims 25 and 28, do not claim a practical application with a tangible result, that language claiming:

identifying (emphasis added) a Systems Management solution scope;

inventorying existing information technology and Systems Management components within the Systems Management solution scope;

mapping existing information technology and Systems Management components to architectural building blocks of a predetermined enterprise service delivery technical model;

identifying which architectural building blocks are required to deliver the Systems Management services to the customer; and

mapping the inventoried existing information technology components that were mapped (above) to the architectural building blocks of the predetermined enterprise service delivery technical model identified as required to deliver the Systems Management services to the customer, resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope.

2.3 For at least these reasons, the Examiner respectfully posits that the claims of the present invention do not meet the criteria for a statutory process. Accordingly, method claims 25-27 and computer program product claims 28-30 are determined to be a program per se, consisting of software instructions that implement the method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a

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customer, whereby the method does not manipulate appropriate subject matter, and thus cannot constitute a statutory process (MPEP Section 2106(IV)(B)(2)(c)).

Allowed Claims

3. Claims 25-30 are deemed allowable over the prior art of record at this time, pending resolution of any rejections noted above.

Examiner's Remarks

4. Applicant states in the remarks section of the current amendment, *"First of all, claims 25-30 do not necessarily claim a computer program. Instead, the claims are also covering a process or method for performing those steps, wherein the output result is a list of design objects and relationships between the design objects that would deliver the Systems Management services in accordance with the Systems Management solution scope. It is not necessary that a computer be employed in whole or in part to perform the processes recited in these claims. Nevertheless, claims 25-30 do recite statutory subject matter, since they do not merely recite an abstract idea or mathematical algorithm without the output of any useful result."*

4.1 In light of this statement, the examiner respectfully notes the following items in response to applicant's remarks:

1) In response to applicant's assertion that *the claims do not necessarily claim a computer program, and that it is not necessary that a computer be employed in whole or in part to perform the processes recited in these claims*, the examiner respectfully directs applicant's attention to

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the specification, on pages 36 and 37, and Fig. 18, where a data processing system is described that may be used for the present invention. Indeed, beginning on line 18 of page 36, implementations of the invention as a computer system programmed with sets of instructions for executing the method, and as a computer program product, are described. Furthermore, on page 37, lines 12-17, applicant discloses that: *"Note that the invention may describe terms such as comparing, validating, selecting, identifying, or other terms that could be associated with a human operator. However, for at least a number of the operations described herein which form part of at least one of the embodiments, no action by a human operator is desirable. The operations described are, in large part, machine operations processing electrical signals to generate other electrical signals."*

The examiner respectfully posits that applicant's assertion that the *claims do not necessarily claim a computer program, and that it is not necessary that a computer be employed in whole or in part to perform the processes recited in these claims*, does not : a) reflect the invention as disclosed on the pages noted above, and b) fails to identify which, if any, portions of the claimed invention are indeed human operator operations, or the preferred and larger-in-part machine operations. For at least these reasons, the examiner respectfully considers the present invention, at least in a larger part, to be a set of instructions, implemented on a computer, at least whole or in part, for performing the processes recited in the present claims, and thus cannot constitute a statutory process.

2) Also, the examiner did not provide a rejection under 101 as per the invention being an abstract idea or mathematical algorithm, and disagrees with applicant's assertion that *"claims 25-30 do recite statutory subject matter since they do not merely recite an abstract idea or*

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mathematical algorithm without the output of any useful result." The 101 rejection is based on the invention being a program per se, consisting of software instructions that implement the method, and not an abstract idea or mathematical algorithm.

3) In accordance with the interim guidelines for 101 subject matter eligibility, which are now included in section 2106 of the MPEP 8th Edition, the Examiner respectfully notes that the stated tangible output result of a list of design objects and relationships between the design objects, must be conveyed to a user in a real-world application of the tangible result.

5. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Response Guidelines

6. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION, AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6.1 Any response to the Examiner in regard to this final action should be

directed to: Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, or the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279. Inquires of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist (571) 272-2100.

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mailed to: Commissioner of Patents and Trademarks
P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to: (571) 273-8300

Hand-delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

Date: 13-November-2006

A handwritten signature in black ink, reading "RUSSELL FREJD", is written over a horizontal line.

**RUSSELL FREJD
PRIMARY EXAMINER**